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REMARKS

Claims 1-7, 9-16, 24-28 and 30-38 are currently pending in this application. Claims 6 and 27 have been amended. Claims 31-38 have been added. Reconsideration of the application in view of the following comments is respectfully requested.

New Claims and Claim Amendments

Support for new claims directed to resorcinol derivatives, Claims 31-32, 34-35, and 37-38, can be found in paragraph [0150] of the present application. Applicants submit that these claims do not constitute new matter.

Claims 6 and 27 have been amended to clarify the dependency of the claims. Claims 33 and 36 have been added for the same reason. Applicants submit that these amendments and additions do not constitute new matter.

Response to the Examiner's §103 Rejections

The §103(a) Rejection of Independent Claims 1, 10, and 24 over Hirose in view of Collette

The Examiner has rejected Claims 1-5, 7, 9-10, 12-14, 16, 24-26 and 28 under 35 U.S.C. §103(a) as being unpatentable over Hirose et al. (U.S. Patent No. 4,844,987, hereinafter "Hirose") in view of Collette et al. (U.S. Patent No. 5,628,957, hereinafter "Collette").

In order to demonstrate a prima facie case of obviousness the Examiner must meet three basic requirements. See M.P.E.P. § 2143, p. 2100-129. "First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." Id. The fact that references can be combined or modified does not render the combination obvious unless there is a motivation or suggestion to do so. See M.P.E.P. § 2143.01. Second, there must be a reasonable expectation of success and third, the prior art references, or combination of references, must teach or suggest all claim limitations. See M.P.E.P. § 2143, p. 2100-129.

With respect to the suggestion or motivation to combine or modify, the Examiner cannot use hindsight to pick and choose elements from the references to reject the pending claims.

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the

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examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

In the present case, the Examiner has not demonstrated a prima facie case of obviousness. The Examiner has not shown a suggestion or motivation to combine Hirose and Collette. As discussed below, Hirose does not disclose a second layer comprising a thermoplastic material as recited in Claims 1, 10, and 24. Hirose only teaches the use of PET and polyamide. Hirose does not suggest to one of skill in the art to use other materials or to combine its teachings with any other reference. Moreover, Collette, discloses a three-layer laminate with inner and outer layers of a first material and an interior (core) layer of a second material. Collette does not teach or suggest a two layer combination as recited in Claims 1 and 10 or a multilayer preform or container as disclosed in Claim 24. In addition, Collette does not suggest to one of skill in the art to use the materials disclosed therein with any other reference in order to arrive at the claimed invention. The Examiner is impermissibly using hindsight to pick and choose elements from the references to reject the pending claims.

The Examiner states, in part, that Hirose teaches a laminate consisting of a first and second layer wherein the first layer comprises polyethylene terephthalate having an isophthalic acid content of at least about 2% by weight. The Examiner further states that "Hirose et al. discloses applicant's invention substantially as claimed."

Hirose does not teach or suggest a laminate as claimed in Claims 1 and 10 or a preform or container as claimed in Claim 24. As the Examiner has stated Hirose fails to teach or suggest a second layer comprising a thermoplastic material selected from the group consisting of copolyester barrier materials, phenoxy-type thermoplastics, polyethylene naphthalate, polyethylene naphthalate copolymers, polyethylene naphthalate/polyethylene terephthalate blends, polyethylene terephthalate and combinations thereof.

Accordingly, Hirose does not teach or suggest a laminate as recited in Claims 1 and 10 or a preform or container as claimed in Claim 24 and does not render these claims obvious.

The Examiner further states that Collette teaches the second layer as claimed in Claims 1, 10, and 24 and that it would have been obvious to have provided the second layer of Collette in the multilayer article of Hirose. Applicants respectfully disagree. Collette discloses a three-layer

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laminate with inner and outer layers of a first material, polyethylene naphthalate (PEN) or PEN/PET blends, and an interior (core) layer of a second material, PET. There is no suggestion or teaching in Collette to combine the materials disclosed therein in a two-layer laminate as recited in Claims 1 and 10. Moreover, there is no teaching or suggestion to combine the materials disclosed in Collette in a multilayer container or preform as recited in Claim 24 wherein the first layer, which forms the interior surface of the preform or container, is PET having an isophthalic acid content of at least about 2% by weight. In addition, with respect to recycled or post-consumer polyethylene terephthalate Collette teaches that an adhesive may be required to prevent delamination of layers when recycled or post-consumer materials are used. (see col. 10, lines 53-55). This teaches away from the present claims wherein the layers are directly adhered together without the use of an adhesive.

As there is no suggestion or motivation to combine Hirose and Collette, Applicants submit that the rejection of Claims 1-5, 7, 9-10, 12-14, 16, 24-26, and 28 as obvious over Hirose in view of Collette is improper. Applicants respectfully submit that independent Claims 1, 10, and 24 and all claims depending therefrom, are patentable.

The §103(a) Rejection of Dependent Claims 6, 15, 27 and 30 over Hirose in view of Collette and further in view of either Farha or Hutchinson

The Examiner has rejected Claims 6, 15, 27 and 30 under 35 U.S.C. §103(a) as being unpatentable over Hirose in view of Collette, further in view of Farha (U.S. Patent No. 5,472,753, hereinafter "Farha") or Hutchinson et al (U.S. Patent No. 6,676,883B2, hereinafter "the Hutchinson '883 patent").

Hirose in view of Farha

The Examiner states that Hirose discloses the applicant's invention substantially as claimed however it fails to disclose wherein the second layer of thermoplastic materials is a poly(hydroxyamino ether). The Examiner further states that Farha discloses a second layer of poly(hydroxyamino ether) bonded to a PET layer in a two layer laminate system, therefore it would have been obvious to one of skill in the art to combine Hirose and Farha.

Applicants respectfully disagree with the Examiner's position. There is no motivation or suggestion to combine these two references. As discussed above, Hirose only discloses the use of PET with polyamide. There is nothing in Hirose to teach or suggest replacing the disclosed

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polyamide with any other material or with a blend of materials. As the Examiner admits, Farha does not disclose a second layer of poly(hydroxyamino ether), rather it discloses a blend of poly(hydroxyamino ether) with a certain amount of copolyester. The Examiner is impermissibly using hindsight to pick and choose elements from the references to reject the pending claims. As there is no suggestion to combine Hirose and Farha, Applicants submit that the rejection of Claims 6, 15, 27, and 30 as obvious over Hirose in view of Farha is improper. Applicants respectfully submit that Claims 6, 15, 27, and 30, and all claims depending therefrom, are patentable. In addition, dependent Claims 6, 15, 27, and 30 are also patentable for at least the same reasons as the independent claims from which they depend.

Hirose in view of Hutchinson

As discussed above, Hirose does not disclose the claimed subject matter. Moreover, applicants respectfully submit that the Hutchinson '883 patent is not a proper reference for a 103(a) rejection as it is not prior art under any subsection of section 102, including 102(a), (b), and (e) as the Hutchinson '883 patent was not invented by another or patented or described in a printed publication more than one year prior to the priority date of the present application.

The Hutchinson '883 patent is a divisional of U.S. Patent No. 6,391,408 patent (the '408 patent). The '408 patent did not publish until it issued on May 21, 2002, however its counterpart PCT application published on April 29, 1999. Therefore the earliest publication of the entire disclosure of the '883 patent is April 29, 1999.

The present application is a divisional application of U.S. Patent No. 6,352,426 (the '426 patent) which was filed on April 21, 1999. The '426 patent is a continuation-in-part of the '408 patent. Accordingly, the '883 patent is not prior art as the disclosure contained therein did not publish until April 29, 1999 which is after the April 21, 1999 filing date of the disclosure contained in the present application.

In addition, the Hutchinson '883 patent is not prior art under 102(e) as the present application was invented by the same entity, i.e. the same inventors, therefore, the Hutchinson '883 patent is not a patent "by another" as required by 102(e). In addition at the time of invention the inventors were under the same assignment obligation in the present application as they were for the Hutchinson '883 patent, therefore the Hutchinson '883 patent is not prior art pursuant to 103(c).

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Applicants submit that the rejection of Claims 6, 15, 27, and 30 as obvious over Hirose in view of Hutchinson is improper as Hutchinson is not a proper 103(a). Applicants respectfully submit that Claims 6, 15, 27, and 30, and all claims depending therefrom, are patentable. In addition, dependent Claims 6, 15, 27, and 30 are also patentable for at least the same reasons as the independent claims from which they depend.

The §103(a) Rejection of Dependent Claim 11 over Hirose in view of Collette and further in view of Schloss

The Examiner has rejected Claim 11 under 35 U.S.C. §103(a) as being unpatentable over Hirose in view of Collette, further in view of Schloss et al (U.S. Patent No. 5,851,471, hereinafter "Schloss"). The Examiner states, in part, that while Hirose discloses applicant's invention substantially as claimed it fails to disclose a preform or container wherein the first layer is thinner in the end cap than in the wall portion and the second layer is thicker in the end cap than in the wall portion. The Examiner further states that Schloss discloses a preform or container wherein the first layer is thinner in the end cap than in the wall portion and the second layer is thicker in the end cap than in the wall portion.

Applicants respectfully disagree. As discussed above there is no reason to combine Hirose and Collette. Moreover, Schloss does not disclose a preform or container wherein the first layer is thinner in the end cap than in the wall portion and the second layer is thicker in the end cap than in the wall portion. Schloss discloses the use of equally spaced ribs in the end of the preform wherein the ribs are made of an outer layer 30 material and the spaces in-between the ribs are an inner layer 20 material. (See Figure 4A and col. 4, lines 45-52). Schloss further discloses that when virgin PET is used as the inner layer 20 and recycled PET is used as the outer layer 30 in this rib configuration, the amount of recycled material is minimized thereby providing increased structural strength and durability. (See col. 4, lines 53-65). This disclosure does not teach or suggest a preform or container wherein the first layer is thinner in the end cap than in the wall portion and the second layer is thicker in the end cap than in the wall portion.

Applicants respectfully submit that Claim 11 is patentable over Hirose in view of Collette, further in view of Schloss. In addition, dependent Claim 11 is also patentable for at least the same reasons as the independent claim from which it depends.

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The §103(a) Rejections of Dependant Claims

Applicants respectfully submit that the dependent claims not specifically discussed above are patentable for at least the same reasons as the independent claims from which they depend. Moreover, applicants respectfully submit that the dependent claims include distinct limitations that render them patentable over the cited references.

Conclusion

In view of the foregoing amendments and comments, it is respectfully submitted that the present application is fully in condition for allowance, and such action is earnestly solicited. If, however, any questions remain, Examiner is cordially invited to contact the undersigned so that any such matters may be promptly resolved.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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